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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,164	12/21/1999	YIHWU HAN	HAN-2	3300

7590

03/26/2003

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EXAMINER

TRAN, PHUC H

ART UNIT

PAPER NUMBER

2666

DATE MAILED: 03/26/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/468,164

Applicant(s)

HAN, YIHWU

Examiner

PHUC H TRAN

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-14 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to the applicant filed 12/21/1999. Claims 1-14 are pending in the application. Detailed action is followed:

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the interworking facility, IPDC, egress port, and routing table (in claim 3-6, 12, and 14) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 4-10 and 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the hardware connection" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the packet identifying" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the circuit switching device" in line 5; "the packet identifying" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Moll (U.S. Patent No. 5710760).

- With respect to claims 1-2, 4-5 and 11-13, Moll teaches a method for controlling a loopback test in ATM network, which is interpreted as method of testing telecommunications systems, which include both circuit switching and packet switching components comprising the steps of: a circuit switching component initiating a loopback test that encompasses communications path through a packet switching component (e.g. steps 401-402 in Fig. 4); the packet switching component returning a looped back test message to the circuit switching component (e.g. step 406 in Fig. 4); and the circuit switching component responding to the reception of the returned test message by determining that the path encompassed by the packet switching component is operational (e.g. steps 407-409 in Fig. 4).

- With respect to claim 3, Moll teaches a method for controlling a loopback test in ATM network, which is interpreted as method of testing telecommunications systems that include both circuit switching and packet switching components, and an interworking facility between the

circuit switching and packet switching components, the interworking facility including an Internet Protocol Device Control (IPDC) and an asynchronous transfer mode Switched Virtual Circuit Capability, comprising the steps of: a circuit switching device employing an Asynchronous Transfer Mode address to establish a loopback path (e.g. steps 401-402 in Fig. 4); an interworking facility establishing an ATM Switched Virtual Circuit with the ATM address via an ATM virtual connection using the ATM address (e.g. the VPI and VCT of ATM); establishing the ATM address as a loopback point (e.g. the header of the packet using for the address); and performing a loopback test through the loopback point established in the establishing step (e.g. steps 407-409 in Fig. 4).

- With respect to claims 6-7, Moll further comprises the step of: the interworking facility setting an entry in its routing table (Fig. 3) with the facility address and channel numbers as a looparound address (e.g. the header address).

- With respect to claim 8, Moll teaches wherein the interworking facility removes the routing table entry after at timeout (e.g. col. 5, lines 30-41).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moll (U.S. Patent No. 5710760) in view of Shobatake (Patent No. 5506847).

- With respect to claim 14, Moll teaches a method for controlling a loopback test in ATM network, which is interpreted as a method of testing telecommunications systems that include both circuit switching and packet switching components, and an interworking facility between the circuit switching and packet switching components, the interworking facility including an Internet Protocol Device Control (IPDC) and an asynchronous transfer mode Switched Virtual Circuit Capability (e.g. Fig. 1 and 2), comprising the steps of: a circuit switching device using IPDC to communicate with the interworking facility to set up a loopback path to a designated ATM loopback point identified (e.g. steps 401-402 in Fig. 4); performing a loopback test employing the loopback path established in the setting up step (e.g. step 409 and col. 4, lines 19-21). Moll fails to teach the E.164 ATM address. Shobatake teaches the E.164 ATM address (col. 107, lines 17-30) for establishing international telephone numbers, recommended by ITU-T. The structure allows up to ten digits for use within a national plan, and up to five digits to identify the national destination, which is known as Country Code and specified in I.331. Maximum length permitted is fifteen digits. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to utilize the E.164 ATM address to identify the telephone numbers in international.

Allowable Subject Matter

9. Claims 9-10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUC H TRAN whose telephone number is (703) 308-7471. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RAO SEEMA can be reached on (703) 308-5463. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9314.

Phuc Tran
Assistant Examiner
Art Unit 2664

P.t
March 21, 2003



DANG TON
PRIMARY EXAMINER